

REMARKS/ARGUMENTS

In the Office Action dated April 13, 2006, Claims 1, 7-9, 11-19, 21-25, 31-33, 39-43, 45-51, 54 and 55 were rejected under 35 U.S.C. §102(e) as being anticipated by U.S. Patent Application No. 2002/0083435 A1 to *Blasko et al.* (“*Blasko*”). Claims 2-6, 26-30 and 53 were rejected under 35 U.S.C. §103(a) as being obvious over *Blasko* in view of U.S. Patent Application No. 2002/0083435 A1 to *Rand*. Claims 10, 20, 34 and 44 were rejected under 35 U.S.C. §103(a) as being obvious over *Blasko* in view of U.S. Patent No. 6,950,623 to *Brown*.

Claim 13, 15-16 and 39 have been amended to correct typographical errors. Claims 1, 2, 7, 25, 31 and 49-50 have been amended to clarify and more particularly point out the invention. Claims 1-55 are now pending in the application. Reconsideration of this application is respectfully requested in view of the attached claim amendments and the following remarks.

35 U.S.C. §102 Rejections

In the Office Action, Claims 1, 7-9, 11-19, 21-25, 31-33, 39-43, 45-51 and 54-55 were rejected under 35 U.S.C. §102(e) as being anticipated by U.S. Patent Application No. 2002/0083435 A1 to *Blasko*. Applicants respectfully submit that, Claims 1, 7-9, 11-19, 21-25, 31-33, 39-43, 45-51 and 54-55, as amended, are patentable over *Blasko*.

Blasko teaches a system for “targeted advertising, such as in television programming, such as in television programming delivery systems utilizing set top boxes.” The Office Action has failed to point out and the applicants are unable to determine, where *Blasko* discloses, teaches or even suggests the subject matter of the claimed invention. Among other differences, the cited and applied reference fails to teach, disclose or suggest the element of “providing an advertisement publisher with a profile of the user of client system” from a client system as claimed in amended independent Claims 1, 25 and 49. Nor does the cited and applied reference teach, disclose or suggest sending any subscriber information from a client system. As discussed more fully below, Claims 1, 25 and 49, and their dependent claims clearly recite such elements.

More specifically, as described in the Application, what is claimed is a method, apparatus and system that includes “providing an advertisement publisher with a profile of the user of client system.” *Blasko* merely uses predetermined demographic information:

“advertisements that have been selected or prepared to interest particular subscribers identified, for instance, using geo-demographic information, are inserted into TV programming streams for the identified subscribers by a TV service provider” (Paragraph 7). Alternately, in *Blasko*, “ad selection and insertion can occur at the household level wherein each household ad insertion device (e.g., a STB) receives a plurality of ads from an ad source, such as the network, and selects ads that are most appropriate for the viewer in the household based on predetermined ad selection criteria” (Paragraph 7). In fact, *Blasko* has no mention or suggestion of client system provided profile or subscriber information.

Applicants respectfully submit that the Examiner has not established a *prima facie* case of anticipation. To establish a *prima facie* case of anticipation, the Examiner is obligated to identify where “each and every facet of the claimed invention is disclosed in the applied reference.” *Ex parte Levy*, 17 U.S.P.2d 1461, 1462 (Bd. Pat. App. & Intef. 1990). Furthermore, anticipation requires that each and every claim element must be identical to a corresponding element in the applied reference. *Glaverbel Société Anonyme v. Northlake Mktg. & Supply, Inc.*, 45 F.3d 1550, 1554 (Fed. Cir. 1995). The Office Action fails to present such a *prima facie* case of anticipation.

Claims 1, 11-19, 21-25, 39-43, 45-49 and 54-55

Blasko discloses a Set Top Box (“STB”) targeted advertisement system that determined if a television was turned on. *Blasko* does not teach or suggest a method of providing an advertisement publisher with ad targeting information from a client system. In contrast, amended Claim 1, reads as follows:

1. In a client system, a method of operation comprising
providing an advertisement publisher with a profile of the user of
client system;
caching a plurality of advertisements of various time lengths; and
causing one or more of said cached advertisements to be
synchronously rendered during an advertisement time slot of a streaming
program, replacing advertisements, if any, included in the streaming
program for the advertisement time slot.

The provision of a client system user's profile to an advertisement publisher in the method recited in Claim 1 provides a level of flexibility that is not needed, nor taught by

Blasko. A client system of the invention in Claim 1 is not limited to the targeting information determined at a remote location or burdened by multiple unnecessary advertisements unsuitable to a client system user. Accordingly, for this reason, with regard to Claim 1, it is abundantly clear that Claim 1 is not anticipated by *Blasko*.

In the Office Action, it is correctly recognized that *Blasko* does not teach or suggest providing an advertisement publisher with a profile of the user of client system. However, the Office Action stated that *Blasko* combined with the teaching of *Rand* would remedy this deficiency. Applicants beg to differ. Nowhere in *Rand*, let alone in the cited paragraphs (11, 20 and 22) is there a teaching of “providing an advertisement publisher with a profile of the user of client system.” *Rand* only teaches “preference data provided directly by a subscriber” to a service provider.

Additionally, in *Rand*, the provider network 150 and the advertisers 170 are clearly separate entities. Accordingly, it is abundantly clear that there is no communication in *Rand* with the advertisers 170, let alone “providing an advertisement publisher with a profile of the user of client system.”

Accordingly, for this reason as well, with regard to amended Claim 1 (and corresponding apparatus Claim 25, and system Claim 49) and all the claims dependent therefrom (Claims 2-6, 10-24, 26-30, 34-48 and 53-55) are clearly allowable.

Claims 7-9, 31-33 and 50-52

Claims 7, 31 and 50 have been amended into independent claim form. Claims 7, 31 and 50 (and their dependent Claims 8-9, 32-33 and 51-52) are allowable as *Blasko* fails to teach “adaptively retrieving a plurality of advertisements in a manner that is consistent with a quality objective for receiving and rendering said streaming program on said client system.” These claims include further recitations not taught, disclosed, or even suggested by *Blasko*. A nonexclusive listing of some reasons Claims 7-9, 31-33 and 50-52 are allowable are included below.

For example, Claims 7, 31 and 50 recite “adaptively retrieving a plurality of advertisements in a manner that is consistent with a quality objective for receiving and rendering said streaming program on said client system.” Firstly, *Blasko* does not even mention any reference to a “a quality objective for receiving and rendering said streaming

program” (emphasis added). *Blasko* merely cites a number of techniques for determining whether a television is turned on. In particular, *Blasko* uses that determination to decide whether to display an ad or not, there is no teaching in *Blasko* of “retrieving a plurality of advertisements in a manner that is consistent with a quality objective for receiving and rendering said streaming program on said client system” (emphasis added). The cited portions of *Blasko* merely teach that it is possible to determine that a television is turned on. There is no teaching of “qualitative objectives” of streaming programs. Accordingly, as *Blasko* fails to teach “retrieving a plurality of advertisements in a manner that is consistent with a quality objective for receiving and rendering said streaming program on said client system,” it is clear that *Blasko* does not anticipate amended Claims 7, 31 and 50. For these reasons, in addition to those already noted above, Claims 7, 31 and 50 and their dependent claims are in condition for allowance.

In another example, Claims 8, 32 and 51 include “monitoring one or more performance metrics that are indicative of whether the client system is meeting said performance objective for receiving and rendering said streaming program.” *Blasko* also fails to teach such monitoring. The portion of *Blasko* that was cited as teaching “monitoring” (paragraphs 41-46) does not mention monitoring, let alone “monitoring one or more performance metrics that are indicative of whether the client system is meeting said performance objective for receiving and rendering said streaming program.” *Blasko* merely states that it is possible to determine if a television is turned on. For this reason as well, in addition to those already noted above, Claims 8, 32 and 51 are in condition for allowance.

In another example, Claims 9, 33 and 52 include “adjusting at least one of an operational bit rate and an operational pulse rate.” *Blasko* also fails to teach such adjusting. The portion of *Blasko* that was cited as teaching “adjusting” (paragraphs 44 and 46) has no mention of adjusting either an “operational bit rate” or an “operational pulse rate” as part of adaptively retrieving an advertisement. Yet again, *Blasko* merely states that it is possible to determine if a television is turned on. For this reason as well, in addition to those already noted above, Claims 9, 33 and 52 are in condition for allowance.

35 U.S.C. §103 Rejections

Rejections of Claims 2-6, 26-30 and 53 Under 35 U.S.C. §103(a)

Claims 2-6, 26-30 and 53 have been rejected under 35 U.S.C. §103(a) as being unpatentable over *Blasko* in view of *Rand*. As Claims 2-6, 26-30 and 53 depend from allowable independent Claims 1, 25 and 49, they are allowable for all the reasons already stated above. In addition, as the Examiner is well aware, the determination of the obviousness of an invention requires consideration of the claimed invention as a whole, not merely the differences between the claimed invention and the prior art. *Lear Sigler, Inc. v. Aeroquip Corp.*, 733 F.2d 881, 221 U.S.P.Q. 1025 (Fed. Cir. 1984). Thus, each and every recitation in a claim must be considered in the context of the claimed invention as a whole, not as a collection of individual recitations.

As already noted, *Blasko* describes a system for “targeted advertising, such as in television programming, such as in television programming delivery systems utilizing set top boxes.” In the Office Action, it is correctly recognized that *Blasko* does not teach or suggest providing an advertisement publisher with a profile of the user of client system. However, in the Office Action it is stated that *Blasko* combined with the teaching of *Rand* would remedy this deficiency. Applicants beg to differ. Nowhere in *Rand*, let alone in the cited paragraphs (11, 20 and 22) is there a teaching of “providing an advertisement publisher with a profile of the user of client system.” *Rand* does teach “preference data provided directly by a subscriber” to a service provider.

Additionally, in *Rand*, the provider network 150 and the advertisers 170 are clearly separate entities. Accordingly, it is abundantly clear that there is no communication in *Rand* with the advertisers 170, let alone “providing an advertisement publisher with a profile of the user of client system.”

Claim 2 (and corresponding apparatus Claim 26 and system Claim 50), as amended, also provides “obtaining an advertisement targeted at the user of client system based on said profile.” Neither *Blasko* nor *Rand*, alone or in combination, teach or suggest obtaining an advertisement targeted at the user of client system based on said profile of when the profile has been sent to an advertising publisher from the client system. Accordingly, Claims 2, 26 and 50 and their dependent claims 3-6 and 27-30 contain further elements that may not be taught by a combination of *Blasko* and *Rand*, but are allowable for this reason as well.

Rejections of Claims 10, 20, 34 and 44 Under 35 U.S.C. §103(a)

Claims 10, 20, 34 and 44 have been rejected under 35 U.S.C. §103(a) as being unpatentable over *Blasko* in view of *Brown*. As Claims 10, 20, 34 and 44 depend from allowable independent Claims 1 and 25, they are allowable for all the reasons already stated above. More specifically, the inclusions of *Brown* does not teach or suggest the provision of a client system user's profile to an advertisement publisher. Claims 10, 20, 34 and 44 are allowable for this reason as well.

Relevant Case Law Regarding Asserted 35 U.S.C. §103(a) Rejections

Furthermore, in each of the 35 U.S.C. §103(a) rejections discussed above and asserted in the Office Action, the Examiner has attempted to use the pending application to define the problem to be solved by reference to different elements from the prior art. The Federal Circuit has clearly indicated that any attempt to selectively cull from the prior art to fit a claimed invention is prohibited. In this regard, the Examiner's attention is directed to the following decisions of the Federal Circuit:

When the Board does not explain the motivation, or the suggestion or teaching, that would have led the skilled artisan at the time of the invention to the claimed invention as a whole, we infer that the Board used hindsight to conclude that the invention was obvious...To reach a non-hindsight driven conclusion as to whether a person having ordinary skill in the art at the time of the invention would have viewed the subject matter as a whole to have been obvious in view of multiple references, the Board must provide some rationale, articulation, or reasoned basis to explain why the conclusion of obviousness is correct. *In re Kahn*, 441 F.3d 977, 78 U.S.P.Q.2d 1329 (2006).

[D]etermination of obviousness cannot be based on the hindsight combination of components selectively culled from the prior art to fit the parameters of the patent invention. There must be a teaching or suggestion within the prior art, within the nature of the problem to be solved, or within the general knowledge of a person of ordinary skill in the field of the invention, to look to particular sources, to select particular elements and to combine them as combined by the inventor. *Crown Operations Intern., Ltd. v. Solutia Inc.*, 289 F.3d 1367, 62 U.S.P.Q.2d 1917 (2002).

Although the suggestion to combine references may flow from the nature of the problem, defining the problem in terms of its solution reveals improper hindsight in the selection of the prior art relevant to obviousness. Therefore, when determining the patentability of a claimed invention which combines two known elements, 'the question is whether there is something in

the prior art as a whole to suggest the desirability and thus the obviousness, of making the combination'...We cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention. *Ecolchem, Inc. v. Southern California Edison Co.*, 227 F.3d 1361, 56 U.S.P.Q.2d 1065 (2000). (quoting *Lindemann Maschinenfabrik GMBH v. American Hoist*, 730 F.2d 1452, 221 U.S.P.Q. 481 (1984)). (Emphasis added).

Obviousness may not be established using hindsight. In determining obviousness, the invention must be considered as a whole and the claims must be considered in their entirety. *Kahn v. General Motors Corp.*, 135 F.3d 1472, 45 U.S.P.Q.2d 1608 (1998).

It is impermissible...to engage in a hindsight reconstruction of the claimed invention, using the applicant's structure as a template and selecting elements from references to fill the gaps. The references themselves must provide some teaching whereby the applicant's combination would have been obvious. *In re Gorman*, 993 F.2d 982, 18 U.S.P.Q.2d 1885 (1991).

In reviewing the decisions of the Board which are based on...obviousness grounds, our focus must be whether "the differences between the subject matter sought to be patented and the prior art are such that the *subject matter as a whole* would have been obvious at the time the invention was made." *In re Kaslow*, 707 F.2d 1366, 217 U.S.P.Q. 1089 (1983).

In view of the foregoing, Applicants respectfully request reconsideration and withdrawal of the rejection of amended Claims 2-6, 10, 20, 26-30, 34, 44 and 53. In addition, Applicants suggest that Claims 2-6, 26-30 and 53, which depend directly or indirectly on Claims 1, 25 and 49, are patentably distinct over the combination of *Blasko* in view of *Rand*. Applicants further suggest that Claims 10, 20, 34 and 44 which depend directly or indirectly on independent Claims 1, 25 and 49 are patentably distinct over the combination of *Blasko* in view of *Brown*.

CONCLUSION

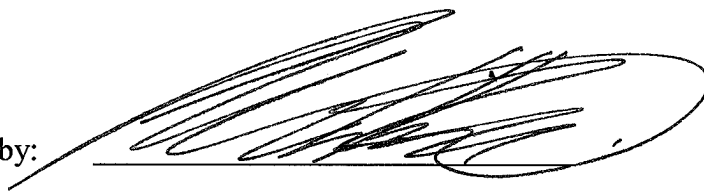
Applicants submit that all pending claims are in condition for allowance. Accordingly, early and favorable action allowing all of the pending claims and passing this application to issue is respectfully requested. The Examiner is respectfully requested to contact the undersigned at the telephone number below if there are any remaining questions regarding this application.

Respectfully submitted,

HALLISKY & PHILIPP

Date: July 6, 2006

by:

A handwritten signature in black ink, appearing to read 'Adam L.K. Philipp', written over a horizontal line.

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